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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,603	09/22/2003	John Steven Cianflone		6365

7590 10/04/2004  
John Cianflone  
Box 275  
Rockville, MA 20848

EXAMINER

ARYANPOUR, MITRA

ART UNIT PAPER NUMBER

3711

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/665,603	CIANFLONE, JOHN STEVEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mitra Aryanpour	3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03 February 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

The PTO Office has not received Form PTO/SB/81 or any other form of written authorization that indeed Mr. Kenenth M. Berner of Lowe Hauptman Gilman & Berner, LLP is authorized to act on applicant's behalf.

#### *Information Disclosure Statement*

1. The information disclosure statement filed 11 March 2004 "Supplemental" fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is a duplicate of already submitted IDS dated 03 February 2004. Additionally, the IDS filed on 11 March 2004 are a substantial duplicate of the IDS as originally filed. Therefore, the IDS as originally filed as also not been considered. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1). For purposes of examination the IDS dated 03 February 2004 has been considered.

#### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: on pages 2 and 3 of the Amendment to the Specification "and/or translucent inner core"; "and/or translucent outer covering"; and on page 5, line 9 of the Amendment to the Abstract, "inner core may also provide . . .".

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3. The disclosure is objected to because of the following informalities: see MPEP 608.01 “USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS”: In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications. The initials S.I. stand for “Le Système International d' Unités,” the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology. Appropriate correction is required for the above objection.
4. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with “I (or We) claim”, “The invention claimed is” or the equivalent. MPEP 608.01(m).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 2, lines 2 and 4 “substantially translucent”; In claim 3, line 2, “substantially

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opaque and translucent inner core” and on line 5 “substantially opaque and translucent outer covering”; In claim 7, lines 1 and 2, “substantially opaque and translucent inner core” and on lines 2 and 3, “substantially opaque and translucent outer covering”; In claims 14, 16 and 27, “inner core has an actual diameter of 27 mm”; In claims 15, 17 and 19, “inner core has an actual diameter of 25 mm”.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 4-10, 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation "said inner core means" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim. It appears that it should be “said inner core”.

10. Claim 2 recites the limitation "said inner core means" in line 6. There is insufficient antecedent basis for this limitation in the claim. It appears that it should be “said inner core”.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Chavarria et al (4,116,439).

Regarding claim 1, Chavarria et al shows a billiard ball having a generally spherical outer surface, comprising: (a) a substantially opaque inner core (weighted object 71; see figure 3), having a predetermined size, that visible through the spherical outer surface;, and (b) a sufficiently transparent outer covering (by way of example see figure 10) of a predetermined size, surrounding and encasing said inner core means (weighted object), wherein said outer covering displays said inner core and provides an outer surface circumference. It should be noted: the preamble, [a billiard training ball], does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Additionally, it should be noted: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the inner core can serve as a target at which to aim a cue stick when addressing said billiard training ball to practice cueing technique when striking the billiard ball.

Regarding claim 2, Chavarria et al shows a billiard ball having a generally spherical outer surface, comprising: (a) a substantially translucent inner core (in as much as applicant has shown and described translucent, Chavarria et al also shows a translucent inner core; see column 7, lines

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55-57) having a predetermined size, that visible through the outer surface, and (b) a sufficiently translucent outer covering (in as much as applicant has shown and described translucent, Chavarria et al also shows a translucent outer surface; by way of example see figure 10) of a predetermined size, surrounding and encasing said inner core, wherein said outer covering displays said inner core and provides an outer surface circumference. It should be noted: the preamble, [a billiard training ball], does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Additionally, it should be noted: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the inner core can serve as a target at which to aim a cue stick when addressing said billiard training ball to practice cueing technique when striking the billiard ball.

Regarding claim 3, note the rejection of claim 1.

Regarding claim 4, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

Regarding claim 7. During normal use and operation of the Chavarria et al device, the method steps set forth by applicant in the claim is inherently provided. Such steps including but

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not limited to the following: providing a substantially opaque inner core of a predetermined size and a sufficiently transparent outer covering of a predetermined size, comprising the steps of: aligning a cue stick with the training ball; and striking the training ball with the cue stick directed toward the inner core in order to impart spin or no spin while limiting deflection to the training ball.

Regarding claim 8, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5, 6, 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chavarria et al (4,116,439).

Regarding claim 5, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 6, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is



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desired. Therefore, it would have been obvious to make the ball of Chavarria et al the same weight as the cue ball so that it can be used as a target or aiming ball.

Regarding claim 9, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 10, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is desired.

Regarding claim 11, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

Regarding claim 12, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 13, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is desired.

Regarding claims 14-19, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from

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the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

### ***Double Patenting***

15. Applicant is advised that should claim 16 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Godfrey; Haber and Sakai.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MITRA ARYANPOUR  
PATENT EXAMINER

MA  
29 September 2004